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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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MOTOROLA, INC. 1303 EAST ALGONQUIN ROAD IL01/3RD SCHAUMBURG, IL 60196				
EXAMINER				
SQUIRES, BRETT S				
ART UNIT		PAPER NUMBER		
2431				
NOTIFICATION DATE		DELIVERY MODE		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

Docketing.US@motorola.com

Office Action Summary

Application No.

10/550,109

Applicant(s)

OLIVEREAU ET AL.

Examiner

BRETT SQUIRES

Art Unit

2431

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 October 2008.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 9-12 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-4 and 9-12 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 01 October 2008 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB-08)
Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

Claim Objections

1. Claim 1 is objected to because of the following informalities: claim 1 recites "a roaming mobile terminal," on line 2 page 4 of the amendment submitted October 1, 2004 and claim 1 recites "said mobile terminal," on line 10 page 4 it is unclear whether the recited claim limitation are intended to refer to the same mobile terminal.
2. Claim 2 is objected to because of the following informalities: claim 2 recites "a mobile node," on line 5 page 2 of the amendment submitted October 1, 2004 and claim 2 depends from independent claim 1 which recites "a roaming mobile terminal," it is unclear whether the recited claim limitation are intended to refer to the same mobile terminal.
3. Claim 3 is objected to because of the following informalities: claim 3 recites "a mobile terminal," on line 6 page 5 of the amendment submitted October 1, 2004 and claim 3 depends from independent claim 1 which recites "a roaming mobile terminal," it is unclear whether the recited claim limitation are intended to refer to the same mobile terminal.
4. Claim 4 is objected to because of the following informalities: claim 4 recites "a mobile node," on line 10 page 2 of the amendment submitted October 1, 2004 and claim 4 depends from independent claim 1 which recites "a roaming mobile terminal," it is unclear whether the recited claim limitation are intended to refer to the same mobile terminal.
5. Claim 10 is objected to because of the following informalities: claim 10 recites "a mobile node," on line 2 page 7 of the amendment submitted October 1, 2004 and claim

10 depends from independent claim 9 which recites "a roaming mobile terminal," it is unclear whether the recited claim limitation are intended to refer to the same mobile terminal.

6. Claim 11 is objected to because of the following informalities: claim 11 recites "a mobile terminal," on line 6 page 7 of the amendment submitted October 1, 2004 and claim 11 depends from independent claim 9 which recites "a roaming mobile terminal," it is unclear whether the recited claim limitation are intended to refer to the same mobile terminal.

7. Claim 12 is objected to because of the following informalities: claim 12 recites "a mobile node," on line 10 page 7 of the amendment submitted October 1, 2004 and claim 12 depends from independent claim 9 which recites "a roaming mobile terminal," it is unclear whether the recited claim limitation are intended to refer to the same mobile terminal.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 1-4 and 9-12 are rejected under 35 U.S.C. 102(e) as being anticipated by Leung et al. (US 7,246,373).

Leung discloses a method of communication between a private network ("Private Network" See figure 1 ref. no. 117) and a roaming mobile terminal ("Client" See figure 1 ref. nos. 103, 105 and col. 1 lines 49-66), the private network including a home agent ("VPN Server" See figure 1 ref. no. 107) for the mobile terminal and a gateway ("VPN Server" See figure 1 ref. no. 107) through which the communication passes and which provides security protection for the private network, the protocols of the communication ("IPsec" See col. 4 lines 65-67 and col. 5 lines 1-3) include security association bundles each including a security association between the mobile terminal and the gateway for inbound communication ("Subnetwork Address for Client" "Subnetwork Address for VPN Server" and "Enterprise Address" See col. 4 lines 12-49) and another security association for outbound communication ("Subnetwork Address for Client" "Subnetwork Address for VPN Server" and "Enterprise Address" See col. 4 lines 12-49), the method performing in response to a handover of communication causing an IP address of the mobile terminal to change to a new IP address ("Client moves from a first subnetwork to a second subnetwork" See col. 1 lines 49-66), the mobile terminal updates its inbound security association from the gateway so that it can receive packets sent to it with the new IP address as destination ("The VPN client automatically obtains a second subnetwork address" See col. 9 lines 13-15), the mobile terminal sends a first signaling message with the home agent as destination in a secure tunnel to the gateway ("The VPN Client automatically attempts to re-establish the VPN tunnel by sending the second

subnetwork address, a username, and a password to the VPN server" See col. 9 lines 13-37), the first signaling message indicating the new IP address in secure form to home agent ("VPN server and client allow encryption of messages" See col. 5 lines 32-43), the inbound security association of the gateway from the mobile terminal accepts the first signaling message without checking its source address ("The user name and password information are verified instead of the source address" See col. 5 lines 32-43), the gateway forwards the first signaling message within the private network to the home agent ("The examiner respectfully points out that the VPN server is being construed as being a part of the private network."), the home agent checks the validity of the first signaling message ("The user name and password information are verified instead of the source address" See col. 5 lines 32-43) and, if it is valid, updates its address data and sends a second signaling message to the gateway indicating the new address ("The VPN server will generate an internal message to grant the client access to virtual private network by updating the subnetwork address of the client in response to verification of the user name and password" See col. 5 22-43), and the gateway updates its outbound security association with the mobile terminal in response to the new address indicated ("The tunnel to the VPN server is created" See col. 9 lines 13-37).

Regarding Claims 2 and 10:

Leung discloses the communication between the client and the VPN server is in accordance with an IPSec protocol specification (See figures 4A-4B, 6, col. 4 lines 65-67 and col. 5 lines 1-3).

Regarding Claims 3 and 11:

Leung discloses the communication between the client and the VPN server is in accordance with an encapsulating security payload protocol used in tunnel mode ("Encapsulated Portion" See figures 4A-4b, 6, ref. no. 415, col. 4 lines 65-67, col. 5 lines 1-3, and col. 7 lines 1-15).

Regarding Claims 4 and 12:

Leung discloses a registration reply for the client is included in the second signaling message ("The enterprise address of the client is registered with the new subnetwork address" See col. 9 lines 13-37).

Response to Arguments

10. Applicant's arguments filed October 1, 2008 have been fully considered but they are not persuasive.

In response to applicant's argument that Leung is not based on and explicitly excludes the use of Mobile IP as a mobility protocol, the examiner respectfully points out that the claims do not recite any claim language limiting the method of communication and the communication system to Mobile IP communications protocol. The examiner further points out that the claims do not specify that the roaming mobile terminal has a permanent IP address and a care of IP address that is associated with the network the roaming mobile terminal is visiting and in response to a handover of communication the care of IP address changes to a new care of IP address. The claims instead recite "an IP address," "a new IP address," and "in response to a handover of

communication, causing an IP address of said mobile terminal to change to a new IP address." Accordingly, the claimed method of communication and the communication system are anticipated by the method of communication and the communication system disclosed by Leung.

In response to the applicant's argument that the method and system of communication disclosed Leung requires complex additional intelligence on the mobile node that is not required by the applicant's method and system of communication, the examiner respectfully points out the inclusion of additional unrecited elements is permitted in rejecting the claims because the claims recite the open ended transitional phrase comprising. The examiner further points out that the complexity of the mobile node is a secondary consideration and is not relevant to anticipation under section 102. Evidence of secondary consideration, such as unexpected results or commercial success is irrelevant to 35 U.S.C. 102 rejection and thus cannot overcome a rejection so based. See *In re Wiggins*, 488 F.2d 538, 543, 179 USPQ 421, 425 (CCPA 1973)

In response to applicant's argument that Leung expresses the need for mobility message generation at the VPN client side which is not present in applicant's invention, the examiner respectfully points out the inclusion of additional unrecited elements is permitted in rejecting the claims because the claims recite the open ended transitional phrase comprising. The transitional term "comprising", which is synonymous with "including," "containing," or "characterized by," is inclusive or open-ended and does not exclude additional, unrecited elements or

method steps. See *Mars Inc. v. H.J. Heinz C.* 377 F.3d 1369, 1376, 71 USPQ2d 1837, 1843 (Fed. Cir. 2004)

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **BRETT SQUIRES** whose telephone number is (571) 272-8021. The examiner can normally be reached on 9:30am - 6:00pm Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on (571) 272-3795. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/BS/

/Christopher A. Revak/

Primary Examiner, Art Unit 2431